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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/644,321

08/20/2003

Irina Travkina

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AVON PRODUCTS, INC.
AVON PLACE
SUFFERN, NY 10901

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

07/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/644,321

Applicant(s)

TRAVKINA ET AL.

Examiner

JYOTHSNA A. VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 22-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 22-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/7/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of amendment and remarks filed on 4/2/07 and IDS filed on 6/7/07. Claims 19-21 have been canceled as per applicant's amendment dated 4/2/07. Claims 1-18 and 22-37 are pending in the application and the status of the application is as follows:

Information Disclosure Statement

The references cited on PTO-1449 have been crossed out since the examiner on PTO-892 cited these references.

Claim Rejections - 35 USC § 112

Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-3 lacks antecedent basis with respect to " other source amino acids ". The expression " other source amino acids" is without metes and bounds.

Response to Arguments

Applicant's arguments filed 4/2/07 have been fully considered but they are not persuasive.

Applicants argue that claims 2-3 have been amended.

In response to the above argument, claim 1 does not recite " other amino acids". Note that claims 2-3 are further limiting the scope of claim 1. Additionally, the expression " other source of amino acids" lacks clarity and the metes and bounds cannot be determined from the disclosure.

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Claim Rejections - 35 USC § 102

Claims 1-4, 6-9, 23-26, 28 and 32-37 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 6,264,933 ('933).

See examples 1-4. "Wheat protein hydrolysate" reads on the claimed keratin-conditioning agent. All other ingredients comprise mascara base. Since the base and keratin conditioning agent is same, the composition would be expected to have the claimed viscosity measured by Brookfield Viscometer at 77° F. All the examples are drawn to "mascara compositions" and all the examples has keratin-conditioning agent "hydrolyzed vegetable protein" and therefore the compositions are also useful for increasing the resistance of hair fibers of eyelashes to breaking.

Products of identical chemical composition can not have mutually exclusive properties."

A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)

Response to Arguments

Applicant's arguments filed 4/2/07 have been fully considered but they are not persuasive.

Applicant argues:

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Nothing in '933 discloses the claimed invention (i.e. a mascara base and a keratin conditioning agent in an amount effective to improve the aesthetic appearance of a keratinous fiber as seen in the figures submitted with the application). '933 is a patent directed to waterproof mascara and as is seen in the examples of '933 has very strong film formers, including the wheat protein hydrolysate. The waterproof mascara of the '933 patent, with such strong film formers necessarily teaches away from the present invention. Contrary to the Examiner's assumptions, there is nothing in the '933 reference that supports a finding that the wheat protein hydrolysate is a keratin conditioning agent in the '933 examples. There is nothing in the '933 patent that teaches the conditioning of the keratinous fibers. Nor do the Examiner's expectations regarding the viscosity of the materials of the '933 patent support a finding of anticipation.

In response to the above argument, claims are drawn to composition. Applicants define at page 2, mascara base. See below.

DETAILED DESCRIPTION

The composition of the present invention is preferably an emulsion (also referred to herein as "mascara base"), more particularly, an oil-in-water emulsion.

Applicant's attention is also drawn to paragraph bridging paragraph pages 7-8.

It should be noted that the present invention also contemplates improving conventional mascaras by adding thereto a keratin-conditioning compound and/or adding an emollient/moisturizing agent in amount(s) effective to achieve the desired improvement. The improvement can be, among others, one or more of the following: conditioning of the eyelashes, moisturizing of the eyelash fibers, increasing the resistance of eyelashes to breaking. These improvements are as compared to eyelash hair fibers that have been treated with a like composition that does not contain the keratin conditioning agent and/or emollient/moisturizing agent. When the present invention is used to improve

conventional mascara compositions, the conventional mascara composition may also be referred to as the "mascara base".

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Therefore compositions present in examples can be mascara base or Patent '933 uses isododecane in the examples. Isododecane is oil. All the examples have water and thus the presence of water and oil forms an emulsion. This meets the claim requirement of "mascara base". Claim 1 does not recite the range of the oil and since the keratin conditioning agent claimed is same to that disclosed in the examples, the mascara of patent '933 also improve the aesthetic appearance of keratin fiber. With respect to applicants argument that the strong film formers teaches away from the invention, the expression "comprising" in the claims is inclusive of the film formers in major amounts. The use of the term "comprising" permits the presence of other ingredients and does not preclude the presence of other ingredients, active or inactive, even in major amounts. Moleculon Research corp., v. CBS, Inc., 793 F. 2d 1261, 229 USPQ 805 (FED. Cir. 1986); In re Baxter, 656 F. 2d 679, 210 USPQ 795, 803 (CCPA 1981).

With respect to the viscosity, claim 1 recites mascara base and keratin conditioning agent and the compositions of patent '933 has mascara base and keratin conditioning agent and therefore the compositions of '933 have also claimed viscosity. Applicants have not presented evidence that the examples do not have the claimed viscosity.

Claims 1-4, 6-10, 23-26, 28 and 32-37 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 6,274,131 ('131).

See examples 1-2 and 6-8. "Wheat protein hydrolysate" reads on the claimed keratin-conditioning agent. Panthenol in example 8 reads on claimed "emollient/moisturizing agent". All other ingredients comprise mascara base. Since the base and keratin conditioning agent is same, the composition would be expected to have the claimed viscosity measured by Brookfield

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Viscometer at 77° F. All the examples are drawn to “ mascara compositions” and all the examples has keratin-conditioning agent “ hydrolyzed vegetable protein” and therefore the compositions are also useful for increasing the resistance of hair fibers of eyelashes to breaking.

Products of identical chemical composition can not have mutually exclusive properties.”

A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)

Response to Arguments

Applicant's arguments filed 4/2/07 have been fully considered but they are not persuasive.

Applicants argues:

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discloses compositions (as in the '131 reference) having very high film formers and as such would not teach a conditioning mascara as in the present invention but rather would teach away from a conditioning mascara.

With respect to applicants argument that the strong film formers teaches away from the invention, the expression “ comprising “ in the claims is inclusive of the film formers in major amounts. The use of the term “ comprising” permits the presence of other ingredients and does not preclude the presence of other ingredients, active or inactive, even in major amounts.

Moleculon Research corp., v. CBS, Inc., 793 F. 2d 1261, 229 USPQ 805 (FED. Cir. 1986); In **re Baxter**, 656 F. 2d 679, 210 USPQ 795, 803 (CCPA 1981).

Claims 1-2, 6-10, 23-26, and 32-37 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 5,053,221 ('221)

See examples 1-3. "Crosilk liquid and Crosilk" reads on the claimed keratin conditioning agent, which is silk amino acids and mixtures thereof". Panthenol in example 8 reads on claimed " emollient/moisturizing agent". All other ingredients comprise mascara base. Since the base and keratin conditioning agent is same, the composition would be expected to have the claimed viscosity measured by Brookfield Viscometer at 77° F. All the examples are drawn to " mascara compositions" and all the examples has keratin-conditioning agent " hydrolyzed vegetable protein" and therefore the compositions are also useful for increasing the resistance of hair fibers of eyelashes to breaking.

Products of identical chemical composition can not have mutually exclusive properties."

A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)

Response to Arguments

Applicant's arguments filed 4/2/07 have been fully considered but they are not persuasive.

Applicants argues:

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This patent discloses compositions having very drying affects on the keratinous fibers. This reference also discloses the use of alcohols, which are known to be very drying, in mascaras and as such would not teach a conditioning mascara as in the present invention but rather would teach away from a conditioning mascara

In response to the above argument all the examples are to mascara compositions and the compositions reads on the claimed mascara base and the compositions also have claimed keratin conditioning agent. The expression “ comprising “ in examples is inclusive of alcohols. Applicants have not presented any evidence showing that the mascara disclosed in the patent is not conditioning mascara.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, and 6-18, 22-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 6,264,933 ('933) and 6,214,329 ('329).

Patent '933 as explained above. Patent '933 does not disclose in the examples limitations of claims 11-18, 27, and 29-31. Patent '933 teaches the claimed emollient/moisturizing agents. See col.6, lines 26-33 for the various oils. These include claimed grape seed oil, sesame oil, macadamia oil, avocado oil and jojoba oil. See col.7, lines 3-7 for the percentage of the non-volatile oil. See col.7, lines 10-68 for the waxes and the percentage of waxes that can be used. Patent '933 at col.8, lines 1-10 teach hydrogenated plant oils, which are wax-like materials. See examples 2-4, where patent teaches that the compositions are useful for curling eyelashes. Patent '933 does not teach the wax-like material, which is specifically claimed in claims 30-31. However patent '329 teaches mascara compositions using waxes at col.5, lines 15 through col.6, lines 1-5. Patent also teaches the claimed oils at col.8, lines 7-14 and at col.12, lines 1-5 teaches wax-like materials, which are rosin, shellac and derivatives thereof. Patent at col.13, lines 5-8 teaches as biologically active agents hydrolyzed wheat protein. This is also claimed in the instant application as conditioning agent. See col.13, lines 24-27, where patent teaches that the compositions are useful for lengthening, thickening, curling eyelashes and providing color to the eyelash.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '933 by adding oil to the compositions and adding waxes and wax-like materials expecting beneficial effect to the eyelashes. One of ordinary skill in the art would be motivated to add the oils, and wax-like materials to the compositions with the reasonable expectation of success that oils will provide moisturizing effect

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and wax-like materials has the additional advantage of providing to the eyelashes film forming properties and the eyelashes having the conditioning agent, film forming polymer (wax-like substance), moisturizing agent and waxes are useful for lengthening, curling, and thickening the eye lash. This is prima facie case of obviousness.

Response to Arguments

Applicant's arguments filed 4/2/07 have been fully considered but they are not persuasive.

Applicants argue that patent '933 teaches away from the present invention and as such there would be no motivation to look to the '933 patent and patent '933 is directed to mascara compositions that contain harsh ingredients and the present invention is directed to mascara which contain conditioning material and in some instances moisturizing agents.

In response to the above argument, the rejection is based upon combination of patents '933 and '329. Applicants cannot attack one reference when the rejection is based upon the combination of references. With respect to harsh ingredients present in the patent '933 that is not suitable, the expression "comprising" in the claims is inclusive of all the unrecited ingredients in major amounts.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 6,264,933 ('933) and 6,214,329 ('329) as applied to claims 1-4 and 6-18 and 22-37 above, and further in view of Croda brochure, "2002 year in Review".

Patents '933 and '329 do not teach the limitation of claim 5 drawn to specific keratin conditioning agent. Specification at page 6 teaches that this compound is known as "Keravis"

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supplied by Croda. Croda brochure teaches at page 2 that “keravis” improves the structure of the damages hair and it has dual properties that plasticizes the hair by moisturizing from within and lubricates the outer hair to protect the cuticle.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of ‘933 by adding oil to the compositions and adding waxes and wax-like materials and adding the specific keratin conditioning agent “Keravis” expecting beneficial effect to the eyelashes. One of ordinary skill in the art would be motivated to add “keravis” the oils, and wax-like materials to the compositions with the reasonable expectation of success that “keravis” will strengthen the keratin fiber (eyelashes) by providing lubrication and moisturization and oils will provide additional moisturizing effect and wax-like materials has the additional advantage of providing to the eyelashes film forming properties and the eyelashes having the conditioning agent, film forming polymer (wax-like substance), moisturizing agent and waxes are useful for lengthening, curling, and thickening the eye lash. This is prima facie case of obviousness.

Applicant have not addressed this rejection and this rejection is maintained.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37


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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JYOTHSNA A VENKAT Ph. D
Primary Examiner
Art Unit 1615